

REMARKS

Claims 1-24 are currently pending in the application. The Action of February 1, 2006 requires election under 35 U.S.C. §121 between five groups of claims relative to five mutations in the biotinidase gene: G98:d7i3, Q456H, R538C, D444H and A171T.

Applicants hereby provisionally elect the claims relative to the G98:d7i3 mutation, forward primer having SEQ ID NO. 4, reverse primer having SEQ ID NO. 9 and anchor probe having SEQ ID NO. 14 with traverse.

The Office Action states that the Markush group set forth in claim 2 is not considered to constitute a proper genus. Applicant respectfully disagrees. MPEP 803.02 states that unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility. In the instant case, the members of the Markush group are all variations (mutations) of the same gene, that is, the biotinidase gene, thus they share a ***substantial*** structural feature, the structure of the biotinidase gene; they differ only at a single point. Thus they constitute a proper genus of mutant biotinidase genes.


As such, they share a common utility, that is, as useful biomarkers for identifying a biotinidase deficiency in an individual. Thus, the five mutations that are members of the Markush group of claim 2 meet the test enunciated in ***In re Harnisch*** and do not represent patentability distinct inventions.

Even if they were directed to independent and distinct inventions, which in the present case, they are not, MPEP 803 further states that, if the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits.

Withdrawal of the restriction is respectfully requested.

An action on the merits and a notice of allowance therefore, are respectfully requested. If further clarification is required in connection with this application, the Examiner is invited to contact applicants' attorney at the below-listed telephone number.

Respectfully submitted,


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